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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/410,368	09/30/1999	JOHN R. HAVENS	244/006	6760

34263 7590 02/13/2004

O'MELVENY & MEYERS
114 PACIFICA, SUITE 100
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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/410,368	HAVENS ET AL.	
	Examiner	Art Unit	
	Ardin Marschel	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-17, 21-24, 28-34, 36-39 and 67-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-17, 21-24, 28-34, 36-39 and 67-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed 11/10/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

NEW MATTER

Claims 1-4, 7-17, 21-24, 28-34, 36-39, and 67-89 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The NEW MATTER rejection as originally applied to claims 6, 19, 26, and 80 is maintained over the same NEW MATTER claim limitations which are now in all independent claims as well as remaining in claim 80. Therefore, this rejection is also necessitated by amendment due to this inclusion of said NEW MATTER in all instantly pending claims via said independent claims. Applicants argue that written basis for the practice of electrode potential for pH change to produce acidic or basic conditions is provided in several citations in the specification. Each of these citations has been considered, will be commented on as follows, and are not persuasive. Page 6, lines 18-20, cite only electronic pH change and do not describe any acidic or basic resultant pH

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nor that an electrode causes such a change, as now required in the instant claims.

Page 7, line 19, through page 8, line 5, describes pH change via electronic potential but without citing either acidic or basic pH conditions or an electrode per se. Page 10, lines 12-18, describes low pH conditions for acetal group oxidation but fails to describe generic activation as in the instant claims nor that an electrode is utilized for this practice nor that basic pH conditions are produced as now cited in the instant claims. Page 20, lines 4-17, describes electrode influence of pH but without describing any acidic or basic conditions of pH as now required in the instant claims. Page 37, line 25, through page 38, line 23, describes pH change and pH which is made high or low for producing free thiols but fails to disclose generic R group activation or acid or basic conditions per se. Page 40, lines 6-9, describes low pH produced in 0.1 m KCl solution but without defining this as acidic or basic nor that it is produced via an electrode nor that this is a practice for generic activations. Page 41, lines 14-24, discloses low pH acetal hydrolysis in 0.1 M KCl but without any written basis for electrode practice therein, acidic or basic conditions, or generic pH activation practice. To summarize none of the citations pointed to by applicants supply written basis for the above described NEW MATTER. Consideration of the entirety of the instant disclosure has also failed to reveal written basis for the above indicated NEW MATTER thus supporting this rejection.

PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-16, 21-24, 67, 72, 73, 75, 81, 82, 84, and 87-89 are rejected under 35 U.S.C. 102(b) and (e)(2) as being clearly anticipated by Heller et al. (P/N 5,632,957).

This rejection is maintained and reiterated from the previous office action, mailed 7/22/03, in anticipation of removal of the above noted NEW MATTER therefore leaving the claims rejected as before. No other arguments have been set forth regarding this rejection other than the non-persuasive arguments directed to NEW MATTER.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 7-17, 21-24, 28-34, 38, 67, 69, 72, 73, 75, 81, 82, 84, and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller et al. (P/N 5,632,957); taken in view of Meade et al. (P/N 5,770,369).

This rejection is maintained and reiterated from the previous office action, mailed 7/22/03, in anticipation of removal of the above noted NEW MATTER therefore leaving the claims rejected as before. No other arguments have been set forth regarding this rejection other than the non-persuasive arguments directed to NEW MATTER.

Claims 1-4, 7-17, 21-24, 28-34, 38, 67, 69, 72, 73, 75, 81, 82, 84, and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller et al. (P/N 5,632,957); taken in view of Meade et al. (P/N 5,770,369); taken further in view of Dorner et al. (P/N 6,121,489).

This rejection is maintained and reiterated from the previous office action, mailed 7/22/03, in anticipation of removal of the above noted NEW MATTER therefore leaving the claims rejected as before. No other arguments have been set forth regarding this rejection other than the non-persuasive arguments directed to NEW MATTER.

No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

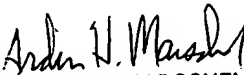
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571)272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571)272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571)272-0549 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

February 6, 2004


ARDIN H. MARSCHEL
PRIMARY EXAMINER